

1 Ben M. Davidson (State Bar No. 181464)
ben@dlgla.com
2 DAVIDSON LAW GROUP, ALC
4500 Park Granada Blvd, Suite 202
3 Calabasas, California 91302
Office: (818) 918-4622
4 Fax: (310) 473-2941

5 David W. Long (admitted *pro hac vice*)
longdw@ergoniq.com
6 ERGONIQ LLC
8200 Greensboro Dr. Suite 900
7 McLean, VA 22102
Office: (202) 847-6853

8 *Attorneys for Plaintiff DMF, Inc.*
9

10 **IN THE UNITED STATES DISTRICT COURT**
11 **FOR THE CENTRAL DISTRICT OF CALIFORNIA**

12 DMF, Inc., a California corporation,
13 Plaintiff,

14 v.

15 AMP Plus, Inc. d/b/a ELCO Lighting,
a California corporation; and

16 ELCO Lighting Inc., a California
17 corporation,

18 Defendants.
19

Civil Action No. 2:18-cv-07090 CAS
(GJS)

**Plaintiff DMF's *Ex Parte*
Application To Permit Filing
Surreply Declaration To Address
New Argument and Factual
Misrepresentations ELCO Made In
Its Reply On Motion to Amend**

Ctrm: 350 W. First. Street, Room 8D
Hon. Christina A. Snyder

1 TO THE COURT AND ALL PARTIES AND THEIR ATTORNEYS OF
2 RECORD:

3 Please take notice that Plaintiff DMF, Inc. (“DMF”) hereby applies *ex parte*
4 for permission to file a declaration addressing new arguments and new factual
5 misrepresentations presented by Defendants (“ELCO”) for the first time in their
6 Reply (Dkt. 214) in support of ELCO’s Motion to amend its invalidity contentions
7 (Dkt. 192).

8 ELCO’s opening and penultimate arguments in its Reply brief (Dkt. 214)
9 present new argument premised on new false representations to the Court that DMF
10 did not comply with the parties’ agreed claim construction disclosure and briefing
11 schedule. ELCO represents to the Court that “[t]he parties agreed that their
12 respective opening claim construction briefs exchanged on April 9, 2019, would
13 include arguments in favor of all of their respective claim construction positions.”¹
14 That is false.

15 As shown in written correspondence between the parties (attached to the
16 declaration DMF seeks to submit here), the parties agreed to divide-up briefing the
17 claim terms so that DMF would do an opening brief only on certain claim terms
18 DMF identified and ELCO would do an opening brief only on certain claim terms
19 ELCO identified; the parties then would provide rebuttal briefs.

20 Specifically, on March 22, 2019, both parties exchanged terms that they
21 believed should be construed: DMF identified four terms (including “open front
22 face”) and ELCO identified ten terms (also including “open front face”). On April 4,
23 the parties conferred on the identified claim terms. The parties agreed to divide-up
24 the claim terms so that DMF would do an opening brief only on the four claim terms
25 DMF identified (including “open front face”) and ELCO would do an opening brief
26 only on nine claim terms that ELCO identified (but not “open front face”); the
27

28 ¹ Dkt. 216-2 at 10:18-20 (emphasis added).

1 parties then would file responsive briefs. The very same day, on April 4, ELCO's
2 counsel sent an email confirming that agreement:

3 we [ELCO] ...can agree to your briefing order, in that **each side will**
4 **brief their identified terms in their opening briefs and address the**
5 **other side's terms in the responding brief**, except that DMF will
address 'open front face' in its opening brief, and Defendants will
respond as to that term in their responding brief. [emphasis added]

6 The next day, on April 5th, ELCO's counsel sent another email stating that
7 "we have decide [sic: decided] to cover 'open front face' in our opening claim
8 construction brief." DMF replied that "We will proceed as indicated below [in
9 ELCO's email]." ELCO then refused to discuss specific claim terms that ELCO had
10 identified for construction, because ELCO asserted that construing those terms "has
11 no bearing on the brief you [DMF] are preparing for next week" (*i.e.*, DMF's
12 Opening Brief on claim construction).

13 Consistent with this agreement, ELCO's own opening brief construed only the
14 ten claim terms that ELCO identified **but not** the three additional terms identified by
15 DMF ("driver", "standard junction box" and "closer to"), which DMF addressed in
16 its opening brief. In sum, the parties agreed that each parties' opening brief would
17 address only the claim terms that party identified for construction, and that's what
18 both parties actually did.

19 ELCO's Reply Brief, however, starts with the misrepresentation that "DMF
20 has not complied with the claim construction disclosure and briefing schedule to
21 which the parties previously agreed" and then doubles-down on that
22 misrepresentation by dedicating **an entire section of argument** to that falsehood
23 ("F. DMF Litigates Under a Double Standard To Gain an Unlevel Playing Field").
24 ELCO feigns prejudice based on these misrepresented facts, which ELCO argues
25 justifies granting ELCO leave to amend its contentions. To further its
26 misrepresentation, ELCO conceals from the Court the email correspondence
27 discussed above that describes the parties' actual agreement.
28

1 Had ELCO raised this new argument and misrepresentation in its Opening
2 Brief, then DMF would have addressed it in Opposition. But ELCO raised them in
3 Reply. Good cause exists to allow DMF to file a declaration that provides the
4 factual background and attached email exchanges evidencing the parties' actual
5 claim construction agreement that shows ELCO's new argument is without merit.

6 This *ex parte* application is based on the attached Memorandum of Points &
7 Authorities; the concurrently filed Declaration of Ben M. Davidson (which is also
8 the proposed surreply declaration that DMF seeks leave to file); and such further
9 argument and evidence as may be considered by the Court on this application.
10 Submitted herewith is a proposed order permitting the filing of the declaration from
11 DMF's counsel Ben Davidson.

12 NOTICE HAS BEEN GIVEN that DMF moves the Court *ex parte* for
13 permission to supplement the record with a surreply declaration.

14 Notice of Application to Counsel. On June 11, 2019 at 11:48 a.m., in
15 accordance with Local Rule 7-19, DMF gave notice to Defendants' counsel, Mr. Bob
16 Boone III and Mr. Daniel Crowe by email exchange of DMF's intention to file this
17 application today and asking for a response by 2:00 p.m. regarding whether ELCO
18 would oppose the application. ELCO's counsel, Mr. Crowe, responded that DMF
19 was seeking "extraordinary relief" and requested a copy of this *ex parte* application
20 and the supporting declaration. A copy of this filing was provided to ELCO's
21 counsel at 12:57 p.m., along with an email informing ELCO's counsel that ELCO
22 has 48 hours to file its opposition and asking again that ELCO provide a response by
23 2:00 p.m. DMF explained its concern that the record be corrected while the Court
24 may be reviewing the briefs. DMF also explained that if a response was not
25 provided by 2:00 p.m., that it would understand that ELCO would oppose the
26 application. DMF did not receive a response as requested and therefore understands
27 that ELCO opposes the application.
28

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2
3 Dated: June 11, 2019

Respectfully submitted,
By: /s/ Ben M. Davidson
Ben M. Davidson (State Bar No. 181464)
ben@dlgla.com
DAVIDSON LAW GROUP, ALC
4500 Park Granada Blvd, Suite 202
Calabasas, California 91302
Office: (818) 918-4622
Fax: (310) 473-2941

7
8 David W. Long (admitted *pro hac vice*)
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ERGONIQ LLC
8200 Greensboro Dr. Suite 900
McLean, VA 22102
Office: (202) 847-6853

11 *Attorneys for Plaintiff DMF, Inc.*
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MEMORANDUM OF POINTS AND AUTHORITIES

I. Factual Background

The Court's Scheduling Order (Dkt. 129) provided a claim construction briefing schedule as follows:

March 22	Parties exchange claim terms to be construed
April 9	Parties exchange opening claim construction briefs
April 22	Parties serve rebuttal claim construction briefs.

On March 22, the parties exchanged lists of claim terms to be construed:

- DMF identified 4 terms: driver, open front face, closer to, and standard junction box.²
- ELCO identified 10 terms: rear face, closed rear face, significantly dissipates, substantially heat conducting, open front face, center axis, such that the light source module is closer to ..., rear heat conducting portion, wherein the light source module is positioned inside ..., and unified casting.³

Both parties identified the term "open front face" (underlined above), but otherwise identified different terms.

On April 4, the parties met and conferred on claim construction and their views on the different identified terms. The parties agreed to divide up briefing the claim terms so that DMF would do an opening brief only on the 4 claim terms that DMF had identified (including "open front face") and ELCO would do an opening brief only on the 9 claim terms ELCO had identified (not "open front face"). Each party's rebuttal briefs would then address the claim terms addressed in the other party's opening brief. The parties also scheduled a follow-up call the next day to address any further claim construction issues.

That same day, April 4, ELCO's counsel sent an email confirming the agreed briefing process and ELCO's belief that no more discussion was needed:

To follow up from our meet and confer call regarding claim term construction, we [ELCO]:

² DMF's Identification of Claim Terms (Boone Decl. (Dkt. 192-9) Ex. H).

³ ELCO's Identification of Claim Terms (Boone Decl. (Dkt. 192-8) Ex. G).

1 (c) can agree to your briefing order, in that each side will brief their
2 identified terms in their opening brief and address the other side's terms
3 in the responding brief, except that DMF will address "open front face"
in its opening brief, and Defendants will respond as to that term in their
responding brief.

4 Let me know if the foregoing addresses all outstanding issues from our
5 call, and whether we still need to have the call scheduled for tomorrow
at 2pm.⁴

6 DMF responded by email the next day that "We will proceed as indicated" and also
7 sought to address "other outstanding issues" on certain claim terms that ELCO had
8 identified for claim construction briefing.⁵ ELCO responded that ELCO would
9 cover "open front face" in its opening brief and reiterated ELCO's view that no
10 further discussion was necessary:

11 Lastly, we have decide [sic: decided] to cover "open front face" in our
12 opening claim construction brief.

13 Based on the foregoing, I don't think we need to have our 2pm PDT
call. Let us know if you think we still do.⁶

14 DMF responded that the parties still needed to discuss three claim terms identified
15 by ELCO for construction: significantly dissipates, substantially heat conducting and
16 center axis.⁷ DMF called into the dial-in number that ELCO setup for the follow-up
17 claim construction call, but ELCO refused to join the call, stating "no call was
18 necessary."⁸ DMF insisted that more explanation was needed on those three claim
19 terms, and ELCO responded there was no need to discuss them because **DMF's**
20 **opening brief would not address them:**

21 The issues raised below related to claim terms that Elco is proposing
22 require construction, **which has no bearing on the brief you are**

23
24 ⁴ Email String of April 4-5, 2019 at 5 (ELCO Email of April 4 at 4:22pm EST)
(Davidson Sur-Reply Decl. **Ex. A**).

25 ⁵ *Id.* at 4 (DMF Email of April 5 at 7:27am EST).

26 ⁶ *Id.* at 3-4 (ELCO Email of April 5 at 10:01am EST).

27 ⁷ *Id.* at 2-3 (DMF Email of April 5 at 3:48pm EST).

28 ⁸ *Id.* at 2 (DMF Email of April 5 at 4:04pm EST; ELCO Email of April 5 at
5:08pm EST).

1 **preparing for next week** [i.e., the Opening Claim Construction Brief]
2 [emphasis added].⁹

3 On April 9, the parties exchanged opening claim construction briefs.

4 Consistent with the parties' agreement, the parties addressed only the claim terms
5 each had identified (with ELCO first addressing "open front face"). Thus, for
6 example, ELCO's Opening Brief on claim construction did **not** address three terms
7 identified by DMF: driver, standard junction box and closer to.¹⁰ And DMF's
8 Opening Brief likewise did not address terms identified by ELCO, including "open
9 front face".

10 On April 22, the parties exchanged rebuttal claim construction briefs.

11 On April 26, after all claim construction briefing had finished, ELCO sent a
12 letter raising for the first time the false assertion that DMF had not complied with the
13 parties agreed briefing process because DMF had not addressed in its opening brief
14 all of the claim terms identified by ELCO; ELCO threatened to use that false
15 assertion to extort unwarranted concessions from DMF so that ELCO could amend
16 its invalidity contentions.¹¹ DMF responded that ELCO's assertion was not true:

17 First, DMF followed the parties' agreed upon claim construction
18 briefing process. ELCO's threat to misrepresent otherwise to the Court
19 in order to extort unwarranted concessions is disappointing.¹²

20 On May 24, ELCO filed its Motion to Amend (Dkt. 192) at issue here.

21 ELCO's opening brief did not raise the argument and misrepresentation at issue here.

22 On June 3, DMF filed its Opposition (Dkt. 204).

23 Yesterday, on June 10, ELCO filed its Reply (Dkt. 215) that raised for the first
24 time to the Court ELCO's argument and misrepresentation at issue here.

25 Specifically, the second sentence of ELCO's Reply (Dkt. 215 at 1) states that "DMF
26 itself has not complied with the claim construction disclosure and briefing schedule

27

⁹ *Id.* at 1 (ELCO Email of April 5 at 5:35pm EST).

28 ¹⁰ ELCO Opening Br. on Claim Construction (Boone Decl. (Dkt. 192-10) Ex. I)
(*see, e.g.*, Table of Contents list of terms construed).

¹¹ ELCO Letter of April 26, 2019 (Boone Reply Decl. Ex. P).

¹² DMF Email of May 2, 2019 (Davidson Surreply Decl. Ex. B).

1 to which the parties previously agreed.” And ELCO dedicates an entire section of its
2 Reply (Dkt. 215 at 10-11) to this falsehood, entitled “DMF Litigates Under a Double
3 Standard to Gain an Unlevel Playing Field”:

4 The parties agreed that their respective opening claim construction
5 briefs exchanged on April 9, 2019, would include arguments in favor of
6 all of their respective claim construction positions. ...

7 DMF’s opening Claim Construction Brief addressed only three of its
8 four identified terms; DMF failed to address “open front face.” In its
9 Reply Claim Construction Brief, which was served late,¹³ DMF
10 disclosed, for the first time, its desire to proffer constructions for the
11 following six claim terms: (i) significantly dissipates heat; (ii)
12 substantially heat conducting unified casting; (iii) unified casting; (iv)
13 closed rear face; (v) rear heat conducting portion; and (vi) center axis.
14 DMF also addressed, for the first time, its construction of “open front
15 face” in its reply brief. [underline emphasis added]

16 ELCO’s Reply brief does not provide the parties’ email exchange discussed above
17 that showed what the parties actually agreed to do, including (1) agreement that each
18 parties’ opening brief would only address claim terms that party identified for
19 construction; (2) agreement that ELCO would brief “open front face” in its Opening
20 Brief (not DMF); and (3) consistent with that agreement, ELCO’s emphasis that the
21 construction of terms identified by ELCO (significantly dissipates, substantially heat
22 conducting, and center axis) “has no bearing on” DMF’s Opening Brief. ELCO’s
23 Reply also does not confess that—consistent with the parties’ actual agreement—
24 ELCO’s Opening claim construction brief did not address the terms “driver”,
25 “standard junction box” or “closer to” that DMF had identified as terms to be
26 construed.

27 **II. Argument**

28 ELCO’s Reply makes a new argument based on new and false representations
in a transparent attempt to persuade the Court that both sides have failed to comply
with the Scheduling Order, so its Patent Rule 3-6 requirement should be disregarded.

¹³ DMF’s Reply Brief was served several minutes after midnight due to logistical
issues. See DMF Email of April 23, 2019 (Boone Reply Ex. O) (Email time stamps
of 12:25 am, 12:35 am and 12:51am).

1 Where, as here, a moving party has raised new arguments or presented new evidence
2 in a reply to an opposition, the court should permit the nonmoving party to counter
3 the new arguments or evidence.¹⁴

4 Here, as shown in the Factual Background above, ELCO makes new
5 arguments in connection with its Motion to Amend (Dkt. 192) that misrepresents the
6 parties' agreement and actual course of conduct on claim construction briefing. This
7 misrepresentation is the basis for a new argument raised in a section of ELCO's
8 Reply dedicated to that falsehood. DMF requests leave to file the attached Davidson
9 Surreply Declaration in connection with ELCO's Motion to Amend (Dkt. 192) in
10 order to address ELCO's new argument and provide evidence showing the truth of
11 what actually occurred.

12 To allow the Court to rule on ELCO's motion based on the true facts, and to
13 discourage ELCO from similar improper conduct in the future, the Court should
14 grant DMF leave to file the Davidson declaration submitted in support of this *ex*
15 *parte* application as a surreply brief. This declaration presents the Factual

16 ¹⁴ See *WB Music Corp. v. Royce Int'l Broad. Corp.*, No. EDCV 16-600 JGB (DTBx),
17 2018 U.S. Dist. LEXIS 77707, at *4 (C.D. Cal. May 7, 2018)(permitting surreply
18 because "the Reply contains new evidence not introduced in their Motion or
19 addressed in Defendants' Opposition"). See also *Jordan v. Terhune*, No. CIV S-03-
20 1820 LKK KJM P, 2009 U.S. Dist. LEXIS 8523, 2009 WL 276764, *3 (E.D. Cal.
21 Feb. 5, 2009) (citing *El Pollo Loco v. Hashim*, 316 F.3d 1032, 1040-41 (9th Cir.
22 2003)); see also *Oregon Natural Desert Association v. Cain*, 17 F.Supp.3d 1037,
23 1048 (D. Or. 2014) ("When a party has raised new arguments or presented new
24 evidence in a reply to an opposition, the court may permit the other party to counter
25 the new arguments or evidence," citing *Provenz v. Miller*, 102 F.3d 1478, 1483 (9th
26 Cir. 1996) ("[W]here new evidence is presented in a reply to a motion for summary
27 judgment, the district court should not consider the new evidence without giving the
28 [non]movant an opportunity to respond"); *Ioane v. C.I.R.*, No. 3:09-CV-00243-RCJ-
(RAM), 2010 U.S. Dist. LEXIS 71808, 2010 WL 2600689, *3 (D. Nev. Mar. 11,
2010)("Because Plaintiff's reply raised issues not in his initial motion, the Court
grants Defendant leave to file a surreply and will consider Defendant's arguments
raised in its surreply," citing *United States v. Mercado*, No. 2:08-CR-00134, 2009
U.S. Dist. LEXIS 133195, 2009 WL 1575170, *1 (D. Nev. June 2, 2009)).

1 Background above and attaches the email correspondence discussed therein that
2 evidences the parties' actual agreement and course of conduct—consistent with that
3 agreement—in claim construction briefing.

4
5 Respectfully submitted,
6 Dated: June 11, 2019 By: /s/ Ben M. Davidson

7 Ben M. Davidson (State Bar No. 181464)
8 ben@dlgla.com
9 DAVIDSON LAW GROUP, ALC
10 4500 Park Granada Blvd, Suite 202
11 Calabasas, California 91302
12 Office: (818) 918-4622
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20 *Attorneys for Plaintiff DMF, Inc.*
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